

Remarks

35 U.S.C. §102 rejections

In the papers mailed on June 24, 2010 claim 34, claim 35, claim 36, claim 37, claim 38, claim 39, claim 42, claim 43, claim 44, claim 45, claim 46, claim 47, claim 50, claim 51, claim 52, claim 135, claim 136, claim 137, claim 138, claim 141, claim 142, claim 143, claim 145 and claim 149 are rejected under 35 U.S.C. §102(e) as being anticipated by Davis. The Assignee traverses the rejections for anticipation in three ways:

1. First, by noting that all the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established that patent examination needs to be completed "in light of the specification as it would be interpreted by one of ordinary skill in the art." (In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364, 70 USPQ2d 1827 Fed. Cir. 2004, underline added).
3. Third, by noting that the Office Action has failed to establish a *prima facie* case of anticipation. In particular, papers mailed on June 24, 2010 fail to establish a *prima facie* case of anticipation for the rejected claims by: citing a document that does not explicitly or inherently describe one or more limitation for every claim, citing a document that does not have the same level of detail included in the rejected claims, by citing a document that does not arrange the limitations in the same way they are arranged in the rejected claims and by citing a document that describes an invention that would require substantial experimentation to match the functionality of the claimed invention. As summarized in previously filed declarations, the cited document provides substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. §103 rejections

In the papers mailed June 24, 2010 claim 40, claim 41, claim 48, claim 49, claim 139, claim 140, claim 146, claim 150, claim 151 and claim 154 are rejected under 35 U.S.C. §103(a) as being obvious given Davis alone or in combination with Official Notice. The author of the papers mailed June 24, 2010 has cited Davis as a reference and dropped Srivastava as a reference in

rejecting these claims apparently because it teaches away from the claimed invention. The Assignee traverses the rejections for obviousness in a number of ways:

1. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established that a review for compliance with 35 U.S.C. 103 conditions for patentability requires a determination as to whether or not the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. The choice of Davis as the basis for 102 and 103 rejections adds to the substantial existing evidence that the author of the papers mailed June 24, 2010 does not appear to possess the requisite level of skill in the pertinent arts.
3. Third, by noting that the Office Action has failed to establish a prima facie case of obviousness. In particular, the papers mailed on June 24, 2010 fail to establish a prima facie case of obviousness by: citing documents that teach away from the claimed invention, citing documents that fails to teach one or more limitation for every claim, failing to explain the cited combination as required by KSR v Teleflex, citing documents that require a change in principle of operation of the disclosed inventions and citing a document and/or a document combination that would destroy the ability of one or more of the cited inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

In the papers mailed June 24, 2010 claim 144, claim 147, claim 152, claim 155, claim 156, claim 157, claim 158, claim 159, claim 160, claim 161, claim 163, claim 164, claim 165, claim 166 and claim 167 are rejected under 35 U.S.C. §103(a) as being obvious given Davis in combination with Srivastava alone or in combination with Official Notice. The Assignee traverses the rejections for obviousness in a number of ways:

1. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established

that a review for compliance with 35 U.S.C. 103 conditions for patentability requires a determination as to whether or not the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. The choice of Davis as the basis for 102 and 103 rejections adds to the substantial existing evidence that the author of the papers mailed June 24, 2010 does not appear to possess the requisite level of skill in the pertinent arts.

3. Third, by noting that the Office Action has failed to establish a prima facie case of obviousness. In particular, the papers mailed on June 24, 2010 fail to establish a prima facie case of obviousness by: citing documents that teach away from the claimed invention, citing documents that fails to teach one or more limitation for every claim, failing to explain the cited combination as required by KSR v Teleflex, citing documents that require a change in principle of operation of the disclosed inventions and citing a document and/or a document combination that would destroy the ability of one or more of the cited inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

In the papers mailed June 24, 2010 claim 62, claim 63, claim 64, claim 68, claim 69, claim 70, claim 90, claim 91, claim 134, claim 148, claim 153 and claim 162 are rejected under 35 U.S.C. §103(a) as being obvious given Davis in combination with one or more of Bielinski, Ray and Bauer alone or in combination with Official Notice. The Assignee traverses the rejections for obviousness in a number of ways:

1. First, by noting that the claim rejections fail under both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections as the claim rejections were authored by an individual and an organization with an apparently well documented lack of average or ordinary skill in the relevant arts. It is well established that a review for compliance with 35 U.S.C. 103 conditions for patentability requires a determination as to whether or not the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. The choice of Davis as the basis for 102 and 103 rejections adds to the substantial existing evidence that the author of the papers mailed June 24, 2010 does not appear to possess the requisite level of skill in the pertinent arts.
3. Third, by noting that the Office Action has failed to establish a prima facie case of

obviousness. In particular, the papers mailed on June 24, 2010 fail to establish a prima facie case of obviousness by: citing documents that teach away from the claimed invention, citing documents that fails to teach one or more limitation for every claim, failing to explain the cited combination as required by KSR v Teleflex, citing documents that require a change in principle of operation of the disclosed inventions and citing a document and/or a document combination that would destroy the ability of one or more of the cited inventions to function. Rather than providing evidence of obviousness, the cited documents provide substantial evidence of the novelty, non-obviousness and newness of the claimed invention.

Furthermore, the claim rejections are moot because claim amendments are believed to have obviated these rejections.

35 U.S.C. §112 first paragraph rejections

In the papers mailed June 24, 2010 claim 34, claim 44, claim 62, claim 135, claim 136, claim 141, claim 145, claim 150, claim 155, claim 159 and claim 164 are rejected under 35 U.S.C. §112 first paragraph as lacking a written description that would enable those of average skill in the art to make and use the claimed invention. Specifically, the author of said papers has made a series unsupported statement that terms used in the claims were not described in the specification. The Assignee traverses the §112 first paragraph rejection of claims 125 through 150 in several ways.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot. In particular, similar language was allowed in a claim in a copending application (see Appendix for specific claim language).
2. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent level of skill in the art that is not average or better. The written description rejections add to the clear and convincing evidence that the author of said papers and said organization appear to lack the level of skill in the art required to consistently complete a statutory patent examination.
3. Third, by noting that the papers mailed June 24, 2010 have failed to establish a prima facie case that the specification does not meet the requirements of §112 first paragraph.

In particular, the author of said papers has failed to establish a *prima facie* case that the specification does not meet the requirements of §112 first paragraph. MPEP 2163 states that: *"A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. Wertheim, 541 F.2d at 263, 191 USPQ at 97. In rejecting a claim, the examiner must set forth express findings of fact regarding the above analysis which support the lack of written description conclusion.* The author of the papers mailed June 24, 2010 also failed to note that "there is no requirement that the words in the claim must match those used in the specification disclosure" and that the use of words in a claim that do not match those used in the specification does not comprise the incorporation of new matter (see *In re Robert Skvorecz, CAFC 2008-1221*).

Furthermore, claim amendments have obviated these claim rejections.

35 U.S.C. § 112 Second Paragraph Rejections

In the papers mailed June 24, 2010 claims 34-51, 62-64, 68-70, 90-91, 134 and 135-167 are rejected under 35 U.S.C. §112 second paragraph. The Assignee traverses the §112 second paragraph rejection of claims 34-51, 62-64, 68-70, 90-91, 134 and 135-167 in several ways.

1. First, by noting that the assertions regarding the alleged lack of written description are not in compliance with the both standards of the Administrative Procedures Act and are therefore moot.
2. Second, by noting that there is no statutory basis for the claim rejections. The claim rejections are non-statutory because there is no statutory basis for giving any consideration to a written description rejection authored by individuals and/or an organization with an apparent level of skill in the art that is not average or better.
3. Third, by noting that the papers mailed June 24, 2010 have failed to establish a *prima facie* case that the specification does not meet the requirements of §112 second paragraph. In particular, the Assignee notes that the arguments presented by the author

of said papers fail to establish the *prima facie* case required to sustain a §112 second paragraph rejection. *MPEP 2173.02 states that: definiteness of claim language must be analyzed, not in a vacuum, but in light of:*

(A) *The content of the particular application disclosure;*

(B) *The teachings of the prior art; and*

(C) *The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001).* In the case of claims 125 - 150 the author of said papers has failed to establish the *prima facie* case that the specification does not meet the requirements of §112 second paragraph in at least four ways for every rejected claim. The four ways are:

1. by failing to interpret the claims in light of the specification,
2. by failing to provide any evidence that someone of average skill in the relevant arts would have difficulty interpreting the claims,
3. by failing to establish that the limitation(s) in the claims fail to describe the invention and/or
4. by failing to consider the claim as a whole.

These failures may be due to the fact that those authoring the papers mailed June 24, 2010 do not appear to understand any of the scientific and/or engineering principles applicable to the pertinent art.

Furthermore, claim amendments have obviated these claim rejections.

Copending applications

Under the provisions of MPEP § 2001.06(b), the author of the papers mailed June 24, 2010 is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466

F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

A review of co-pending applications has revealed that the apparently routine allowance and issue of patents to large companies for "inventions" that do not appear to meet the requirements for allowance (i.e. novelty, written description, etc.) appears to be having a material, negative impact on the prosecution of the assignee's patent applications. In accordance with the prevailing statutes, the allowance and issue of patents to large companies for inventions that do not appear to meet the requirements for allowance should not have any impact on the prosecution of Asset Trust patent applications. In fact, the U.S.P.T.O. has a professed commitment and a legal obligation to invalidate patents that do not meet the legal requirements for patentability.

Unfortunately, the U.S.P.T.O. appears to be shielding the patents issued to large companies for "inventions" that do not appear to meet the statutory requirements for allowance instead of honoring their statutory obligation to invalidate them. In particular, the Assignee has recently determined that the primary reasons it has been forced to file over twenty appeals all appear to be related to efforts to bolster patents issued to large companies for inventions that do not appear to be novel. These reasons include:

- 1) the need to traverse apparent misrepresentations that prior art that should properly be used to prevent the allowance of (or invalidate) one or more patents issued to a large company is relevant to an Asset Trust patent application. This is the single largest reason the Assignee has been forced to file so many appeals. For example, one reference used to support claim rejections in co-pending application 10/750,792 was U.S. Patent 6,012,053 (hereinafter, Pant). Pant describes a mechanism through which results from a search query are ranked according to user specified relevance factors to allow the user to control how the search results are presented. In particular, the Pant invention provides the user with the ability to assign weights to different attributes of the search results, generate a score for each item in the results using said weights and then present results ranked according to the score.

A comparison on the key features of Pant to the features of the invention claimed in co-pending application 10/750,792 and the features of the invention claimed in *prima facie* invalid U.S. Patents 7,212,996 and 7,433,840 shows that Pant appears to be a much closer match to the issued patents than it is to the rejected claims in the instant application. Although Pant is well known to those of average skill in the art, Pant was not cited during the prosecution of the two issued patents but it was cited during the prosecution of application 10/750,792.

Feature	Pant	7,212,996 & 7,433,840	10/750,792
Primary application	Results from a search query are ranked according to user specified relevance factors	A search application that allows the user to enter a set of criteria of their choice with desired ranges and a weighting factor to be applied to the criteria	Identify impact and value of keywords
User defined relevance factors?	Yes	Yes, user defined criteria	No
User defined weightings?	Yes	Yes	No
Score based on factors and weightings used to sort results?	Yes	Yes	No
Keyword financial impact?	No	No	Yes
Keyword valuation?	No	No	Yes

This approach has clearly been used to support the rejection of the instant application as Ray is a much closer match *prima facie* invalid patent 7,249,080 as they both rely on risk rankings to make security selections. By way of contrast, the system of the present invention relies on a calculated market sentiment value in completing automated security trading.

2) the need to traverse apparent misrepresentations that one or more patents issued to a large company for an "invention" that does not appear to meet the requirements for patentability is relevant to an Asset Trust patent application. This approach has clearly been used in the instant application as Davis does not appear to meet the requirements for patentability when Ranger and Bowman Amuah are properly considered.

3) the need to traverse rejections apparently made without explanation that inventions similar or identical to those found in patents issued to large companies represent non-statutory subject matter.

4) the apparently improper use of Official Notice. This approach has clearly been used in the instant application as the author of the instant papers resorted to the use of Official Notice only after she and her predecessor clearly documented the novelty, non-obviousness and newness of the claimed invention.

- 5) the need to traverse rejections apparently made without evidence that methods and/or claims similar or identical to those found in patents issued to large companies are "too subjective" and/or not enabled.
- 6) the need to traverse rejections made for informalities.
- 7) the need to overcome actions taken by U.S.P.T.O. personnel in apparent violation of one or more statutes, rules or established precedents. These actions appear to be concentrated in Asset Trust applications with pending claims that appear to be similar to those in *prima facie* invalid patents previously issued to one or more large companies.

The subject matter contained in the discussion above may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of the instant application.

- Copies of cited U.S. patent application(s) (papers mailed June 24, 2010s, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- Copies of the cited U.S. Patent Application(s) (papers mailed June 24, 2010s, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

The above-listed co-pending application(s) is not to be construed as prior art. By bringing the above-listed application(s) to the attention of the author of said papers, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

Acknowledgement

The Assignee previously requested: an unbiased patent application examination conducted by an Examiner with knowledge of the relevant arts who follows the law for the instant application. The Office's apparent failure to provide such an examination for the instant application is taken as an acknowledgment that no personnel with the requisite level of skill in the art and/or training in the relevant statutes and precedents are available at the present time. As a result, the instant application has yet to receive its first examination.

Statement under 37 CFR 1.111

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above, there are no references or objections to avoid. Having said that, the Assignee notes that the primary reasons the prior set of claims were amended to put the claims in final form for allowance and issue.

Reservation of rights

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matter covered by the original claims before their cancellation or modification.

Conclusion

The pending claims are of a form and scope for allowance. Prompt notification thereof is requested.

Respectfully submitted,
Asset Trust, Inc.
/B.J. Bennett/
B.J. Bennett, President
Date: November 22, 2010

APPENDIX (allowed claim, underline added)

35. A computer implemented process optimization method, comprising:

transforming a plurality of organization related transaction and text data into an integrated database and a computational model of organization financial performance that relies on a plurality of transformed data inputs and identifies a contribution to an organization market value and an organization risk for each of one or more elements of value, external factors and risks for each of one or more segments of enterprise value by learning from the data, obtaining a process specification that identifies one or more expected process outputs and a plurality of process feature data,

optionally identifying an impact of each process feature on the expected process outputs;

mapping the expected process outputs to the computational model of organization financial performance;

creating a financial simulation model for the organization using said mappings, model and process data;

determining an optimal mix of process features using the output from said simulation model in an optimization analysis, and

displaying the optimal mix using a paper document or an electronic display

where the computational model of financial performance optionally produces one or more reports detailing organization market value and risk by element of value, external factor and risk for each of one or more segments of enterprise value in a matrix of risk or a matrix of value format.